REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1 and 4-6 are now pending in this application. Claims 1 and 4 are herein amended. Claim 6 is added. Support for new claim 6 is found in the Specification at page 9, lines 12-19. No new matter is added.

In the outstanding Office Action, claims 1, 4, and 5 were rejected under 35 U.S.C. § 103(a) as obvious over Katsuichi, JP 05-120781, in view of Hertrich, U.S. 2005/0028180, further in view of Kudara, US 2003/0231571. Claims 1, 4, and 5 were also rejected under 35 U.S.C. § 112, second paragraph. Claim 4 was objected to because of an informality.

Claims 1, 4, and 5 were rejected under 35 U.S.C. § 112, second paragraph. Claim 4 was objected to because of an informality. In response, Applicants herein amend claim 1 and claim 4. With such amendments, it is believed that any indefiniteness or informality is resolved. Accordingly, Applicants respectfully request withdrawal of these rejections and this objection.

Claims 1, 4, and 5 were rejected as obvious over Katsuichi in view of Hertrich, and further in view of Kudara. Applicants respectfully traverse these rejections, as the Office has failed to state a *prima facie* case of obviousness.

Claim 1, from which claims 4 and 5, is directed to a disk recording and reproducing device. The device has a slide member driven by a drive unit through a rack to convey a disk in a horizontal direction from a disk ejecting position, then lowering the disk vertically to position the disk in a disk writing/reading position. In this position, information can be written on and read from the disk by an optical pickup. The slide member has a switch trigger. The device has a detecting unit on its chassis for electrical detection by the switch trigger. This detecting unit is configured to detect a disk standby position which is between

the disk writing/reading position and the disk ejecting position. The disk is moved and placed at the disk standby position based on the detection of the disk by the detecting unit. The disk is stopped in the standby position on upward movement of the device while the disk is conveyed from its disk writing/reading position toward its disk ejecting position. In the disk standby position, the surface of the disk is spaced from the objective lens in order to prevent contact between the objective lens and the surface of the disk even when the objective lens is moved.

Katsuichi discloses a disc recording and reproducing device. The device has a pair of switches that operate when the disk cassette is first inserted into the cassette holder, activating loading of the device. The first switch is activated by the apical surface of the disk cassette when it is inserted. This switch stays in the "ON" position throughout the operation of the device, and through the ejection of the cassette. The second switch serves as the initiator of a second loading force for initiating a reloading operation. *See* Katsuichi at ¶¶ 0021 and 0037. The Office asserts that the two switches are the detecting unit on a chassis of the device for electrical detection by the switch trigger, and that they turn on/off according to the position of the switch trigger of the slide member and detect the disk ejecting position, disk writing/reading position, or standby position, as required by claim 4 of the present application. However, even if these two switches are a "detecting unit" within the meaning of the present application, they clearly do not interact in any way with a switch trigger, because, as acknowledged by the Office, Katsuichi has no switch trigger.

Hertrich discloses a data drive that has a plunger located in the back part of the carrier in which a cartridge is placed. The plunger is depressed when the cartridge is fully loaded, breaking an IR beam. This results in a signal that may instruct the controller of the device to initiate the next step in the loading process. The Office asserts that this teaches a slide member having a switch trigger.

Kudara discloses a disk player that encompasses a position in which the disk is stopped while it is conveyed between a writing/reading position and the disk ejection position. The Office asserts that this discloses a standby position in which the disk is sufficiently spaced from the objective lens to prevent contact between the lens and the disk surface.

The Office has not established a *prima facie* case of obviousness. All of the claims require, *inter alia*, that

> said slide member has a switch trigger, and said disk recording and reproducing device has a detecting unit on a chassis thereof for being electrically detected by said switch trigger, said detecting unit is configured to detect a disk standby position which is between said disk writing/reading position and said disk ejecting position...

None of the cited references teach or suggest this limitation. All of the words in a claim must be considered in judging the patentability of a claim. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 4943, 496 (CCPA 1970). Further, the obviousness inquiry must focus on the claimed invention as a whole, not merely the differences between the prior art and the claimed invention. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025, 1033 (Fed. Cir. 1984). Thus, the device must have a detecting unit for electrical detection by the switch trigger that is on the slide member, which detects when the disk is in a standby position. Katsuichi, with no switch trigger, cannot have a detecting unit for being electrically detected by a switch trigger. Even if the plunger in Hertrich is a switch trigger, Hertrich teaches that the phototransistors detect when the cartridge is loaded, not that they detect a disk standby position which is between the disk writing/reading position and the disk ejecting position. And Kudara discloses a photo-interrupter means for recognizing the presence or absence of the disk in the disk writing/reading position. Assuming *arguendo* that this constitutes a switch trigger, Kudara's "switch trigger" does not detect a disk standby position which is between the disk writing/reading position and the disk ejecting position.

Further, even if the elements of the claimed invention are disclosed by the cited references, combining such references will not result in the present invention. Indeed, the resulting device would be inoperative for the purpose of the present invention. If references taken in combination produce a seemingly inoperative device, the references teach away from such combination, and cannot serve to create a *prima facie* case of obviousness. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001). If the elements allegedly disclosed by Katsuichi were combined with the teachings of Hertrich, the switch trigger would detect when the cartridge was loaded, not when it was in a standby position. Kudara doesn't overcome this deficiency with its disclosure of means for recognizing if the disk is in the disk writing/reading position.

Failing to teach or suggest a detecting unit for electrical detection by the switch trigger that is on the slide member, which detects when the disk is in a standby position, a *prima facie* case of obviousness is not made. Accordingly, Applicants respectfully request the withdrawal of the rejections of claims 1, 4, and 5 and allowance of these claims and new claim 6.

In light of the above discussion, the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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